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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,787	08/28/2003	Rajesh K. Garg	021238-578	5592

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EXAMINER	
FORTUNA, JOSE A	
ART UNIT	**PAPER NUMBER**
1731	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/649,787	GARG ET AL.	
	Examiner	Art Unit	
	José A. Fortuna	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *6-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautam et al., US Patent No. 5,997,691.

Gautam et al. teach a method of making a web in which a base web is moved along a first path, a slurry of cellulosic material is prepared as and add-on to the base web; and repetitive discharging the add-on-material, see for example, paragraph bridging columns 2 and 3. In the same paragraph, Gautam et al. teach that the add-on material is discharged using a moving belt having an orifice along the endless path, same as claim 2 of the current application. Gautam et al. teach also the use of flax straw as the add-on material, see column 12, lines 43-57 and in the same paragraph, Gautam et al. teach that the add-on material is cooked, bleached and then grinded, i.e., refined. The only difference between the claimed invention and Gautam et al. invention is that the way in which the add-on material is ground, i.e., Gautam et al. teach a wet grinding process, while the present application teaches the dry comminution[1] of the add-on materials. However, using either process of grinding is within the levels of ordinary skill in the art, since both of them are very well known in the art. Note that if one desires to do the dry grinding operation, then the steps of pressing and drying the slurry are a necessary and also very well known in the dry market pulp. Wet and dry grinding are functional equivalent processes and it has been held that "[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." In re Fout 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 152 USPQ 618 (CCPA 1967). With regard to claims 4 and 5, the steps of

[1] For example of dry grinding operation see US Patent Nos. 3,596,840; 3,847,363; 3,987,969; 4,166,583; 4,191,335; just to mention a few. All of them cited on PTO-892, attached.

removing shives and contaminants from a pulp is very well known and necessary step(s) after the cooking of the pulp[2].

Response to Arguments

5. Applicant's arguments filed on November 21, 2006 have been fully considered but they are not persuasive.

Applicants argue that the examiner did not cite any documents to evidence the official notice of the equivalence of wet and dry grinding. This is unconvincing, because the examiner cited enough evidence of this fact, see references recited in the footnote on page 3, repeated here for convenience, and also attached in the PTO-892 form. However, more evidence is hereby cited, see below:

- US Patent No. 6,214,166, column 3, lines 5-41 and more specifically, lines 23-25, where they teach that it is customary to use either the wet or dry method for grinding.
- US Patent Application Publication No. 2005/0167534 A1, paragraph [0006], wherein they teach: "Grinding processes include a dry grinding process and a wet grinding process. When a dry product is to be produced by means of a grinding process, in many cases, a dry grinding process, which does not require a drying step, is employed."
- US Patent No. 3,596,840, previously cited, teaches in column 1, lines 46-56, some of the advantages of using dry grinding, instead of a wet grinding: "It has now surprisingly been found that cellulose fluff can be

[2] See for example Chapter 9, Pages 98-132, of Handbook for pulp and paper technologists, 2nd edition, attached.

> advantageously produced starting from pulp in sheet form obtained by conventional methods if the pulp is shredded in dry condition and then, still in dry condition, defibrated in a disk refiner. The use of a disk refiner as disintegrator in the production of fluff according to the present invention has proved to be very advantageous not only economically but also purely technically because disk refiners deliver a pulp containing only 10--15 percent of fiber bundles which is much lower than in previously known methods in spite of the fact that a harder pressed pulp is used as starting material. Despite the more effective defibration the risk for fiber cutting is not greater than in previously known methods. Further it is surprising that it is possible to treat dry pulp in a disk refiner in which otherwise only wet pulp can be treated. Earlier experiments have namely shown that the pulp is stopped in the refiner if the moisture content falls below a certain value and is burnt so that it sticks to the refiner. The processing of dry, shredded pulp according to the present invention involves certain requirements as to the milling disks of the refiner."

As to the advantages of the use of the dry comminution, one of ordinary skill in the art would expect the same disclosed results since the prior art teaches the same results, i.e., less energy to produce the same/similar fiber/particle sizes, see for example US Patent No. 3,596,840.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Method of adding add-on materials to cellulosic webs."

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

José A Fortuna
Primary Examiner
Art Unit 1731

JAF